

#### REMARKS

Claims 1, 3-17 and 19-21 are pending in the above-referenced patent application. Claims 1, 8 and 17 are independent. Claims 2 and 18 were previously canceled.

Claims 1-3, 5 and 8-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ellis. Dependent claims 4, 6, 7 and 21 stand rejected under 35 U.S.C. § 103(a) as having been obvious in view of Ellis.

Claims 1, 8 and 17, the only independent claims, have each been amended to recite: "wherein the step of matching the recorded time and channel comprises positioning the broadcast to correspond to the recorded time and channel, extracting an available offer associated with the recorded time of the recorded channel, wherein the available offer is either a pre-recorded audio segment or a pre-recorded video segment;" or similar language. Ellis does not disclose or describe at least this quoted claim feature.

Ellis describes a system for allowing users to record programs. Ellis does not teach the ability of a system to extract segments of programs corresponding to a user's selection. An example may be instructive. Under Ellis, a user watching music videos on television can use the activate button of Ellis to record the entire music video program, which is likely 30 or 60 minutes in length. In sharp contrast to this, and a required element of the present invention, a user interested in the current song being performed in the music video being broadcast can use the activate button of the current invention to have a

copy of this song e-mailed to the user (or distributed to the user through any number of other distribution methods). Ellis does not teach this patentable feature. Accordingly, claims 1-3, 5 and 8-20 are not anticipated by Ellis.

Concerning the obviousness rejection of claims 4, 6, 7 and 21, these dependent claims derive from claims 1, 8, and 17 and thus recite the patentable distinction described above.

Furthermore, as the examiner knows, in determining obviousness, "[t]he claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 USPQ 481, 488 (Fed. Cir. 1984).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984).

"The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" Fromson v. Advance Offset Plate, Inc., 225 USPQ 26, 31 (Fed. Cir. 1985).

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Combining Ellis with what was known in the art at the time of the invention produces a system of recording a broadcast after a request is received to record. This is very different from extracting a pre-recorded audio or pre-recorded video segment offered in a broadcast based on a user selection made while viewing the broadcast through a video viewing system. Accordingly, claims 1, 8 and 17 are not obvious in view of Ellis.

Claims 4, 6, 7 and 21 depend upon, and add further limitations to, claims 1, 8 and 17. Accordingly, claims 4, 6, 7 and 21 are not obvious in view of Ellis.

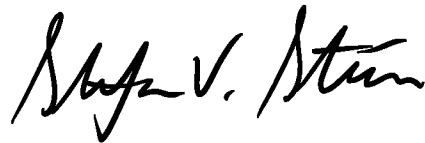
Further, concerning claim 4, the Examiner correctly notes that Ellis does not disclose "an encrypted credit card or debit card number is recorded along with the time and channel being viewed." The Examiner then takes Official Notice that it is well-known in the art to have the ability to "send an encrypted credit or debit card account number." (emphasis added). Respectfully, claim 4 describes a method for recording a credit or debit card number along with the time and channel being recorded. This allows different credit or debit cards to be associated with different recordings. The inventive feature is neither anticipated by Ellis, nor obvious in view of Ellis. Accordingly, claim 4 is not obvious in view of Ellis.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may

be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The Commissioner is hereby authorized to charge any additional fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 50-1667.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stefan V. Stein". The signature is fluid and cursive, with the first name "Stefan" and last name "Stein" clearly distinguishable.

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Stefan V. Stein Reg. No. 29,702  
Holland & Knight LLP  
P.O. Box 1288  
Tampa, Florida 33601-1288  
Telephone: 813/227-8500  
Facsimile: 813/229-0134